

REMARKS

Reconsideration of this application, as amended, is respectfully requested. Claims 10, 22 and 23 have been amended, and are supported by the specification as filed, for example at page 11, line 17 through page 12, line 1; page 19, line 15 through page 20, line 16; page 27, lines 12-19; and figures 10-11. New claim 58 has been added, and is supported by the specification as filed, for example at page 6, lines 3-8. In addition, claim 13 has been amended to track the changes made to its base claim. No new matter is being added by any of the present amendments.

In light of the amendments to claim 10, it is respectfully requested that the claim rejection to claim 10 and its dependent claims under 35 U.S.C. §101 be removed.

Claims 10, 13, 20, 22-23 and 56-58 are patentable over Dustin et al. (US 6496857).

Dustin addresses a system which allows users to select and save Internet advertisements for later use. In response to a user's selection of an advertisement (e.g., banner advertisement), an enhanced version of the selected advertisement is stored. When the user requests access to the stored advertisements, the system delivers a collection of thumbnails of the enhanced advertisements. Upon "mouse over" of a thumbnail, a "glance preview" of the enhanced advertisement is displayed to the user. Upon "clicking" or "double-clicking" a thumbnail, the full enhanced version of the advertisement is displayed to the user. See, e.g., Dustin, Abstract, 4:62-5:17, 5:42-61 and 8:26-36.

However, whether the banner advertisement, thumbnail or glance preview of the advertisement is interpreted as the small form of the advertisement, Dustin fails to teach or suggest that such small form of the advertisement is generated from a print advertisement, as recited in claim 10. In addition, even if two version of advertisements from the group including banner advertisements, thumbnails, glance previews, and full enhanced versions were interpreted as a small and large form of the advertisement respectively, such two versions would fail to satisfy one or more of the following features

of claim 10, including the large form of the advertisement (i) having dimensions larger than the small form (ii) having similar shape and proportions as the small form and (iii) being a magnified version of the small form. Therefore, claim 10 and its dependent claims are patentable over Dustin. Because claims 22-23 recite features similar to those recited in claim 10, claims 22-23 are likewise patentable over Dustin.

With respect to claim 58, Dustin additionally fails to teach that the first Web page including the small form of the advertisement is configured to be displayed for a period of time, and after the period of time has elapsed, automatically serving the second Web page including the large form of the advertisement, in conjunction with the features of the base claim of claim 58. First, banner advertisements cannot be considered as the large form of the advertisement, because Dustin fails to teach or suggest a small form of the advertisement having similar shape and proportions as a banner advertisement. Similarly, thumbnails cannot be considered as a large form of the advertisement, because Dustin does not teach or suggest a version of the advertisements that is smaller than the thumbnails. Therefore, it is not relevant whether or not a banner advertisement and/or a thumbnail is automatically served.

On the other hand, even if a glance preview and/or a full enhanced version of an advertisement were considered a large form of an advertisement, these advertisements are not automatically served in Dustin. Instead, such advertisements are served in response to user input in Dustin. For example, a glance preview is served in response to a mouse over or other activation of a thumbnail (Dustin, 5:46-48, 8:31-33), and a full enhanced advertisement is served in response to clicking (Dustin, 5:55-56), double-clicking and/or other activation of a thumbnail (Dustin, 8:34-36). As Dustin fails to teach or suggest the above-mentioned feature of claim 58 (in conjunction with the features of the base claim of claim 58), claim 58 is patentable over Dustin.

For at least the foregoing reasons, the present claims are patentable over the cited references. If there are any additional fees due in connection with this communication, please charge Deposit Account No. 19-3140.

Respectfully submitted,
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